

REMARKS

Reconsideration of the above-identified patent application is respectfully requested.

Claims 1-5 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,009,372 to Baker et al. (Baker) in view of U.S. Patent No. 5,398,285 to Borgelt et al. (Borgelt) and further in view of U.S. Patent No. 6,488,585 to Wells et al. (Wells). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker, Borgelt and Wells as applied to claims 1-5, and further in view of U.S. Patent NO. 6,173,402 to Chapman. Claims 16-19 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wells in view of Borgelt. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wells in view of Borgelt as applied to claim 16, and further in view of Chapman. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wells in view of Borgelt as applied to claim 16, and further in view of Baker. Claims 6, 10, 20 and 24 are objected to as being dependent upon a rejected base claim, but are indicated as allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Claims 7-8, 11-12, 21-22 and 25-26 are objected to based on their dependence on claims 6, 10, 20 and 24. For at least the following reasons, applicants respectfully traverse these rejections.

Applicants reassert that the cited references fail to teach or suggest at least one limitation of each of applicant's independent claims 1 and 16. As per claim 1, for example, this claim requires "obtaining a software identification code relating to at least

a portion of software information to be downloaded into said embedded system.”

Applicants assert that none of the cited reference teach or suggest this limitation as the Examiner contends. Baker discloses a system for downloading software from support equipment to an embedded system, but no mention is made in this reference of providing any security in the downloading process to ensure that only authorized software is downloaded.

Borgelt, on the other hand, discloses a technique for creating a password to enable operation of a software program. Unlike the claimed invention, however, the software program that is enabled according to the Borgelt technique is already resident within an embedded system. See, for example, col. 2, lines 22 - 25 and col. 5, lines 55 - 58 that characterize the Borgelt technique as generating “a password that enables *an embedded software program* within a communication device” (emphasis added). According to the Borgelt reference, a password is formed as a combination of a hardware ID (107) associated with a base station (101) and an embedded software code associated with the software program embedded within the base station (101); see col. 3, lines 32 - 36 and lines 53 - 58, and col. 4, lines 28 - 48. The password is then used to enable the already embedded software program for operation; see col. 5, lines 14 - 20.

The Borgelt system thus requires the software program to be pre-existing in the base station (101), and the software code or ID is formed from information associated with this embedded software program. The Examiner disagrees with applicants’

previous statement that “applicants’ claim 1 requires the software ID to relate to software information that is not resident within the embedded system, but is instead resident within some other system.” In the Examiner’s view, “[i]t is implied (in claim 1) that the software is present in some other system, but not explicitly stated and the claims do not recite that the software is not resident in the embedded system.

Applicants assert that applicants’ previous statement is an inherent requirement of claim 1; i.e., it necessarily follows from the language of claim 1. More specifically, claim 1 is directed to a “method of authorizing transfer of software into an embedded system.” Claim 1 requires “obtaining a software identification code (SWID) relating to at least a portion of software information *to be downloaded into said embedded system*” (emphasis added). If the at least a portion of the software information is “to be” downloaded into the embedded system, then the at least a portion of the software information clearly has not yet been downloaded into the embedded system. It necessarily follows that if it has not yet been downloaded into the embedded system, the at least a portion of the software information cannot be resident within the embedded system. If the at least a portion of the software information is not resident in the embedded system, it also necessarily follows that it is resident elsewhere, such as in some other system.

It is applicants’ position that the language of claim 1 reciting “obtaining a software identification code (SWID) relating to at least a portion of software information to be downloaded into said embedded system” clearly establishes that the at least a portion of the software information is not yet resident within the embedded system. Borgelt, in

contrast, fails to show, disclose, teach or suggest that the software code or ID used to form the password may relate to any software program other than one that already exists in, i.e., is already resident within, the base station (101), and Borgelt accordingly teaches away from applicants' claimed invention by requiring the software code or ID to relate to a pre-existing, previously embedded software program. The remaining references of record, either alone or in combination, likewise fail to teach or suggest basing a software code or ID that forms part of a password on any software program other than a pre-existing software program embedded within the system that will execute such a software program. Accordingly, the § 103(a) rejection of claim 1 is improper, and withdrawal of this rejection is respectfully requested.

Applicants' claim 16 similarly requires "providing . . . a second identifier relating to software information to be downloaded into an embedded system . . ." Applicants assert that Borgelt fails to show, disclose, teach or suggest this limitation for at least the reasons set forth hereinabove. The Examiner concedes that Wells likewise does not teach this feature. The remaining references of record, either alone or in combination, likewise fail to teach or suggest basing an identifier that forms part of a password on any software program other than a pre-existing software program embedded within the system that will execute such a software program. Accordingly, the § 103(a) rejection of claim 16 is improper, and withdrawal of this rejection is respectfully requested.

Applicants maintain that independent claims 1 and 16 are patentably distinct from the references of record. Since claims 2-15 are dependent upon claim 1, and claims

17-28 are dependent upon claim 16, these claims are likewise believed to be patentably distinct from the references of record. Claims 1-28 are accordingly in condition for allowance, and such action is solicited. The Examiner is cordially invited to contact the undersigned by telephone to discuss any unresolved matters.

Respectfully submitted,



Jeffrey A. Michael
Registration No. 37,394
Barnes & Thornburg
11 South Meridian Street
Indianapolis, Indiana 46204-3335
Telephone: (317) 231-7382
Fax: (317) 231-7433